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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,887	01/25/2002	Ryoichi Nadachi	1712652	8222

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EXAMINER

GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/031,887	Applicant(s) NADACHI ET AL.	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1- 3 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Teagarden et al., (U.S. 6,694,298).

1. As per claim 1, Teagarden discloses a medical information processing system comprising: two or more medical information processing apparatuses connected to the Internet for transmitting patient information from one of the two or more medical information processing apparatuses to the other medical information processing apparatuses by e-mail via the Internet, (Teagarden, Fig. 10; col. 11, lines 17-35; col. 12, lines 28-31; col. 14, lines 23-39)

wherein said medical information processing apparatus on a transmission side includes data recording/reproducing means on the transmission side, data inputting means on the transmission side and data processing means on the transmission side,

(Teagarden, Fig. 10; col. 11, lines 17-35; col. 12, lines 13-31; col. 14, lines 23-39)(receiving and/or storing is considered to be analogous to recording/reproducing).

said data recording/reproducing means on the transmission side has a database for recording patient information, (Teagarden, Fig. 10; col. 13, lines 45-52).

said data inputting means on the transmission side is provided to be able to input the patient information to the database of the data recording/reproducing means on the transmission side, (Teagarden, col. 12, lines 13-31), and

said data processing means on the transmission side is set to check the database based on a predetermined setting condition, and has a program capable of automatically preparing e-mail attached with new patient information in the database and a patient ID in the information, and automatically transmitting the e-mail to one or more predetermined destination medical information processing apparatuses, (Teagarden, Fig. 1A, Fig. 3, Fig. 10; Fig. 16; Col. 2, line 39-Col. 3, line 5; col. 4, lines 39-61; col. 11, lines 17-35; col. 10, lines 45-49; col. 11, lines 41-47; col. 12, lines 28-31; col. 14, lines 23-39; Col. 17, lines 5-36).

2. As per claim 2, Teagarden discloses a medical information processing system according to claim 1, wherein the new information in the database is any one of new data newly added, changed data and partially deleted information, (Teagarden, Col. 17, lines 5-36) (clinical professional calls the patient and utilizes the new information to complete a post patent call clinical evaluation to be added to the database and transmitted to the patient's primary doctor).

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3. As per claim 3, Teagarden discloses a medical information processing system according to claim 1, wherein the setting condition is any one of a specified time interval and a previously specified time, (Teagarden, col. 2, lines 39-52) (disclosing selecting records for analysis based on specified time period that would include both a specific interval and time.) (see also Toyoda, col. 4, lines 8-18, disclosing periodically accessing mail server to download new e-mail).

4. As per claims 12-14, Teagarden discloses a recording medium wherein programs for said medical information processing system are stored, (Teagarden, Fig. 8; col. 12, line 64-col. 13, line 8).

All other claim limitations disclosed by applicant are substantially similar to limitations disclosed in claims 1-3, respectively. Therefore, the grounds for the rejection of claims 1-3 are herein incorporated by reference against claims 12-14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 4-11 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teagarden et al., (U.S. 6,694,298) in view of Toyoda, (U.S. 6,441,916).

6. As per claim 4, Teagarden fails to disclose a medical information processing system, wherein the setting condition is a set capacity of data transmittable as the e-mail. However, such a system is well-known in the art as evidenced by Toyoda, (Toyoda, col. 1, line 10 - col. 2, line 27, col. 5, line 15-col. 6, line 64) (disclosing e-mail limited by set capacity of data, i.e. 1 MB).

It would be obvious to one of ordinary skill in the art in view of Toyoda to make the setting condition correspond to a set capacity of data transmittable as the e-mail. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

7. Claim 5 contains the same limitations as claim 4 and therefore the rejection of claim 4 is incorporated herein by reference.

8. As per claim 6, Teagarden fails to disclose a medical information processing system, wherein the set capacity can be set based on a mailbox having a smaller capacity between mailboxes on the transmission side and the receiving side. However, such a system is well-known in the art as evidenced by Toyoda, (Toyoda, col. 1, line 10

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- col. 2, line 27; col. 3, line 43-col. 4, line 7; col. 5, line 15-col. 6, line 64) (disclosing e-mail limited by storage capacity of server and mailbox).

It would be obvious to one of ordinary skill in the art at the time of the invention to make the set capacity dependant upon the capacity of the smaller mailbox. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

9. Claim 7 contains the same limitations as claim 6 and therefore the rejection of claim 6 is incorporated herein by reference.

10. As per claim 8, Teagarden fails to disclose an information processing system, wherein said data processing means on the transmission side is set to prepare a transmission message file to the effect that the e-mail has been transmitted when automatically preparing the e-mail, and to transmit the transmission message file to any one of the one or more predetermined destination information processing apparatuses and facsimiles placed in places where the information processing apparatuses are located via a transmission route different from a transmission route of the e-mail. However, such a system is well known in the art as evidenced by Toyoda, (Toyoda, Fig. 1, Fig. 3; col. 1, lines 50-55; col. 2, line 53- col. 3, line 55; col. 4, line 12-col. 6, line 64) (disclosing transmission-related processing including analysis and storage corresponding to error and delivery notification, disclosing periodically accessing mail

server to download new e-mail, and disclosing sending a reply message to the administrator instead of the sender, i.e. a different transmission route).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

11. As per claim 9, Teagarden fails to disclose an information processing system, wherein the data processing means on the transmission side is set to prepare a list of transmission message files and to transmit the list to any of the one or more predetermined destination medical information processing apparatuses and the facsimiles placed in the places where the medical information processing apparatuses are located via the transmission route different from the transmission route of the e-mail at any of a certain specified time interval and a previously specified time. However, such a system is well known in the art as evidenced by Toyoda, (Toyoda, Fig. 1, Fig. 3; col. 1, lines 50-55; col. 2, line 53- col. 3, line 55; col. 4, line 12-col. 6, line 64) (disclosing transmission-related processing including analysis and storage corresponding to error and delivery notification, disclosing periodically accessing mail server to download new e-mail, and disclosing sending a reply message to the administrator instead of the sender, i.e. a different transmission route).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The

motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

12. As per claim 10, Teagarden fails to disclose an information processing system, wherein the data processing means on the transmission side is set to prepare a list of transmission message files and to transmit the list to the one or more predetermined destination medical information processing apparatuses via the same transmission route as a transmission route of the e-mail at any of a certain specified time interval and a previously specified time. However, such a system is well known in the art as evidenced by Toyoda, (Toyoda, Fig. 1, Fig. 3; col. 1, lines 50-55; col. 2, line 53- col. 3, line 55; col. 4, line 12-col. 6, line 64) (disclosing transmission-related processing including analysis and storage corresponding to error and delivery notification, and disclosing periodically accessing mail server to download new e-mail).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

13. As per claim 11, Teagarden fails to disclose an information processing system, wherein the medical information processing apparatus on a destination side is set to transmit reply mail to the effect that the list of the transmission message files has been received when receiving the list. However, such a system is well-known in the art as

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evidenced by Toyoda, (Toyoda, col. 1, lines 50-55; col. 4, line 12-col. 6, line 64)(disclosing sending a reply message to the administrator or sender and periodically accessing mail server to download new e-mail).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the medical data processed by Teagarden with the system of Toyoda. The motivation would be to have a successful data transmission, (Toyoda, col. 1, line 63-col. 2, line 27).

14. As per claims 15-22, Teagarden discloses a recording medium wherein programs for said medical information processing system are stored, (Teagarden, Fig, 8; col. 12, line 64-col. 13, line 8).

All other claim limitations disclosed by applicant are substantially similar to limitations disclosed in claims 4-11, respectively. Therefore, the grounds for the rejection of claims 4-11 are herein incorporated by reference against claims 15-22.

Response to Arguments

Applicant's arguments filed June 13, 2006 have been fully considered but they are not persuasive for the following reasons:

Applicant argues that Teagarden fails to teach or suggest a program capable of automatically preparing e-mail attached with new patient information in the database and the patient ID in the information, and of automatically transmitting the e-mail to one or more predetermined destination medical information processing apparatuses.

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However, Teagarden does in fact teach such a program for automatically transmitting e-mails with patient information to the patient's physician, (Teagarden, col. 11, lines 19-22, 41-47). The physician's computer that receives the e-mail is considered to be a predetermined destination medical information processing apparatus.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Joao, (U.S. Pub. 2001/0032099); Killcommons et al., (U.S. 6,424,996); Ohashi et al., (U.S. 6,681,139); and Conner et al., (U.S. 6,851,088).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG
8/31/2006

RSG


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER